

REMARKS

Claims 1-30 are pending in the application. Claims 1-30 have been rejected.

The drawings are objected to. A new Figure 3C has been added to provide a figure which corresponds to the description set forth on page 17, lines 7 – 25. The specification has also been amended to have the numbering correspond to the new Figure 3C. No new matter has been added.

The specification stands objected to for various informalities. It is believed that the amendments to the specification address the informalities. No new matter has been added.

Claims 1-30 stand rejected under King, et al, U.S. Patent No. 5,319,542 (King) in view of the article “Come, and they will built it,” Geller, Scott. June 1999. *Manufacturing Systems* (Geller Article). These rejections are respectfully traversed.

The present invention, as set forth by independent claim 1, relates to a method for a manufacturer to automate a catalog process. The method includes creating a catalog of configurable products including at least one of non-commodity products and services, and presenting a data file, the data file including the catalog, the presenting being via a communication medium to a purchaser. The catalog allows the purchaser to host the data file and to configure non-commodity products.

The present invention, as set forth by independent claim 29, relates to a computer system which includes a processor, memory coupled to the processor, and a communications port configured to transmit a data file. The data file includes a catalog of configurable products with at least one non-commodity product and service to be received by a purchaser. The data file enables the purchaser to incorporate the data file into a procurement system. The catalog allows the purchaser to host the data file and to configure non-commodity products.

The present invention, as set forth by independent claim 30, relates to a system for automating a catalog process. The system includes means for creating a catalog of configurable products with at least one non-commodity product and service; and means for presenting a data

file. The data file includes the catalog presented via a communication medium to a purchaser. The catalog allows the purchaser to host the data file and to configure non-commodity products.

King discloses a system which facilitates the user in electronically ordering items from suppliers. The system includes an electronic catalog and an electronic requisition facility. The electronic catalog includes a public catalog (element 106) and a private catalog (element 110). The public catalog is stored on a publicly available database 104. The private catalog resides on a customer's computer system. The electronic requisition facility enables a customer to electronically create purchase requisitions based upon the information provided in the catalogs and to route the requisitions through the appropriate approval process within an enterprise.

The Geller Article discloses a manufacturing system configurator. The disclosed configurator guides buyers to alternate products that match the customer's requirements, while optimizing the configuration based on the seller's criteria. The Geller article discusses a variety of configurators including features and options configurators, rules based configurators, object oriented configurators, table based configurators and constraint based configurators, as well as configurators which are hybrids of the various types of configurators.

King and the Geller Article, taken alone or in combination, do not teach or suggest a method for a manufacturer to *automate* a catalog process, much less such a method which includes creating a catalog of configurable products including *at least one of non-commodity products and services*, and presenting a data file, the data file including the catalog, the presenting via a communication medium to a purchaser, *the catalog allowing the purchaser to host the data file and to configure non-commodity products*, all as required by claim 1. Accordingly, claim 1 is allowable over King and the Geller Article. Claims 2-28 depend from claim 1 and are allowable for at least this reason.

King and the Geller Article, taken alone or in combination, do not teach or suggest a computer system which includes a processor, memory coupled to the processor, and a communications port configured to transmit a data file where the data file includes a catalog of configurable products with *at least one non-commodity product and service* to be received by a purchaser much less such a system in which the data file enables the purchaser to incorporate the data file into a procurement system and *the catalog allows the purchaser to host the data file and*

to configure non-commodity products, all as required by independent claim 29. Accordingly, claim 29 is allowable over King and the Geller Article.

King and the Geller Article, taken alone or in combination, do not teach or suggest a system for *automating* a catalog process, much less such a system which includes means for creating a catalog of configurable products with *at least one non-commodity product and service*; and means for presenting a data file, the data file including the catalog presented via a communication medium to a purchaser, *the catalog allowing the purchaser to host the data file and to configure non-commodity products*, all as required by independent claim 30. Accordingly, claim 30 is allowable over King and the Geller Article.

Additionally, applicants respectfully submit that the combination of King and the Geller Article is improper because King and the Geller Article are nonanalogous prior art that have been combined with the benefit of hindsight and because King and the Geller Article fail to provide a suggestion to be combined.

King and the Geller Article are nonanalogous prior art because King relates generally to a system for ordering items using an electronic catalog and the Geller Article relates generally to configurators.

The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d, 1443, 1446 (Fed. Cir. 1992)

Additionally, even if King and the Geller Article are found to be within analogous arts, neither King or the Geller Article provide a suggestion for such a combination.

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Wilson and Hendrix fail to suggest any motivation for, or desirability of, the changes espoused by the Examiner and endorsed by the Board.

Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to

piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fritch*, 23 USPQ 2d at 1783-84 (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988)).

Further, it appears that the rejection of claims 1 – 30 is based on an improper hindsight-based obviousness analysis. In this regard, it must be recognized that hindsight reconstruction of claims based on disparate aspects of the prior art may not be employed as a valid basis for the rejection of those claims. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303, 312-313 (Fed. Cir. 1983); *Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593, 1595-1596 (Fed. Cir. 1987). Furthermore, an obviousness determination requires that the invention *as a whole* would have been obvious to a person having ordinary skill in the art. *Connell v. Sears Roebuck & Co.*, 220 USPQ 193 (Fed. Cir. 1983).

To establish obviousness based on a combination of elements disclosed in the prior art or a modification of the prior art, there must be some motivation, suggestion or teaching of the desirability of making the claimed invention. *See In re Dance*, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). The motivation, suggestion or teaching to modify King may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Whether the Office Action relies on an express or implicit showing of a motivation or suggestion to modify or combine Kings, it must provide particular findings related thereto. *In re Dembiczak*, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." *Id.* Thus, the Office Action must include particular *factual findings* that support an assertion that a skilled artisan would have modified the express disclosure of King to develop the invention recited by independent claims 1, 29 and 30. *See In re Kotzab*, 55 USPQ2d 1313, 1317. Applicant is unable to discern the requisite factual basis in King or the Office Action.

In this regard, the Office Action appears to have engaged in a hindsight-based obviousness analysis condemned by the Federal Circuit. To prevent a hindsight-based obviousness analysis, the Federal Circuit has clearly established that the relevant inquiry for

determining the scope and content of the prior art is whether there is a reason, suggestion, or motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to combine or modify Kings. *See Ruiz v. A.B. Chance Co.*, 57 USPQ2d 1161, 1167 (Fed. Cir. 2000); *see also In Re Rouffet*, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (“[T]he Board must identify specifically ... the reasons one of ordinary skill in the art would have been motivated to select the references and combine them to render the claimed invention obvious.”). Applicant can detect, and the Office Action has pointed to, no motivation or suggestion that would prompt someone of ordinary in the art to look to King in combination for a solution to the problem addressed by Applicant’s invention. Such a determination that there is a suggestion or motivation to modify King is a factual finding that is prerequisite to an ultimate conclusion of obviousness. *Sibia Neurosciences, Inc. v. Cadus Pharma. Corp.*, 55 USPQ2d 1927, 1931 (Fed. Cir. 2000). Applicant respectfully submits that the Office Action is devoid of such a finding.

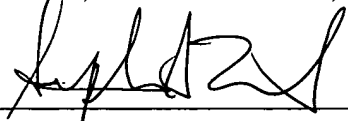
Without such a finding, a *prima facie* case of obviousness in rejecting claims 1 – 30 under 35 U.S.C. § 103(a) based on King has not been made. For this further reason, Applicant respectfully submits that claims 1 – 30 are patentably distinguished over King and Applicant respectfully requests the Examiner to remove the rejections of claims 1, 29 and 30 and the claims depending therefrom.

Furthermore, the Examiner has taken official notice of several facts throughout the course of his Office Action. Although Applicant is not calling for documentary proof of the officially noticed facts in the present Response, Applicant reserves the right to later assert the foregoing should Examiner not find Applicant’s claims allowable.

CONCLUSION

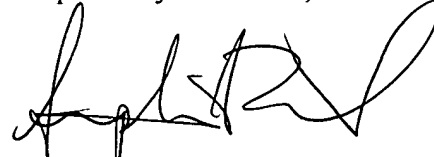
In view of the amendments and remarks set forth herein, the application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the examiner is requested to telephone the undersigned.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on June 30, 2003.


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6/30/03
Date of Signature

Respectfully submitted,



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